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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/713,775	11/15/2000	Jae-Young Jung	12568-002001 / OPP 000771	3088

7590 04/24/2002  
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225 Franklin Street  
Boston, MA 02110-2804

EXAMINER

YEE, DEBORAH

ART UNIT	PAPER NUMBER
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1742

DATE MAILED: 04/24/2002

8

Please find below and/or attached an Office communication concerning this application or proceeding.

VIF-8

# Office Action Summary

Application No.

09/713,775

Applicant(s)

JUNG, JAE-YOUNG

Examiner

Deborah Yee

Art Unit

1742

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 08 March 2002.
- 2a) ☒ This action is **FINAL**.      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1 to 8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1 to 8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)      4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)      5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 7.      6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1 to 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hara et al (JP8-246107 ) or Bjorkroth (US Patent No. 3,700,851) for the reasons set forth in the previous office action of paper no.5 dated September 27, 2001.

Claims 1 to 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over JP 2-101143 or FR 2,566,429, which were submitted by applicant in IDS filed March 12, 2002.

The English abstract of JP'143 and FR '429, each discloses a martensitic stainless steel alloy with constituents whose wt% ranges overlap those recited by the claims; such overlap renders applicant's composition prima facie obvious despite differences in non-overlapping areas, see *In re Malagari*, 182USPQ549.

Also FR '429 on page 7 discloses austenitizing at 1050 to 1150C and tempering at 500 to 600C which overlap with applicant's temperature ranges of 800 to 1150C and 350 to 575C, respectively.

### ***Response to Arguments***

Applicant's arguments filed March 12, 2002 have been fully considered but they are not persuasive. It was argued that Hara and Bjorkroth does not teach a steel

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composition containing a N content that overlaps "0.11-0.25%N," as recited in claims 1,3,5, and 7. It is the examiner's position that Bjorkroth discloses on line 40 of claim 1, column 4, a N range of 0.02 to 0.12%N which would overlap with applicant's N range of 0.11 to 0.25%N. Moreover Hara in the English abstract discloses a N range of 0.005 to 0.1%N which is slightly lower than applicant's N range of 0.11 to 0.25%N. Since applicant has not demonstrated criticality (e.g. by comparative test data), then it would seem that a composition with 0.11% N vs. a composition with slightly less N ( say 0.1%) would depict a mere difference in the proportion of element without any attendant unexpected results and hence would not patentably distinguish over the prior art. Note pages 7 and 8 of applicant's specification indicates that 0.04 to 0.25% N is permissible, with 0.08 to 0.20%N preferred. There is nothing to show that the newly claimed N range of 0.11 to 0.25%N is critical or that it involves anything more than judicious selection; and hence would not define patentable novelty over the prior art.

It was submitted that present invention alloy exhibits high hardness with high yield strength which would be unexpected results considering the high W and N content. It is the examiner's position that Bjorkroth discloses specific examples B to F in column 3 , and Hara discloses specific examples on page 5 which meet the claimed composition, and would therefore inherently possess the present invention properties in absence of proof to the contrary.

### ***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP

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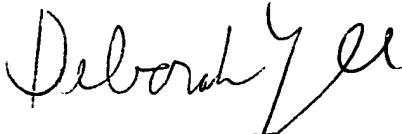
§ 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Deborah Yee whose telephone number is 703-308-1102. The examiner can normally be reached on Monday-Friday from 6:30 to 4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Roy King can be reached on 703-308-1146. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9310 for regular communications and 703-873-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

  
**DEBORAH YEE**  
**PRIMARY EXAMINER**